

Remarks

The Examiner has repeated the Restriction Requirement with respect to independent claims 22 and 34 stating that no corresponding special technical features are present, since both claims are anticipated by the Tabone reference FR '587. The Applicant respectfully disagrees. In particular, as argued in detail below, independent claim 34 has a special technical feature not disclosed by Tabone namely the means for generating a temperature difference between the microtome and the cryostat chamber. This special technical feature is shared by method claim 22 and therefore both claims satisfy the Unity of Invention requirements. The Examiner is therefore respectfully requested to reconsider the withdrawal of the method claims and to examine all claims of record in view of the detailed arguments in support of the lack of anticipation of claim 34 under Tabone 'FR 587, as given below.

Claims 34 through 38, 41 and 43 stand rejected under 35 USC 102(b) as being anticipated by Tabone 'FR 587. Claim 38 stands rejected under 35 USC 102(b) as being anticipated by or in the alternative under 35 USC 103 as being obvious over Tabone '587. Claim 39 stands rejected under 35 USC 103(a) as being unpatentable over Tabone '587 in further view of Krainiak '705. Claim 40 stands rejected under 35 USC 103(a) as being unpatentable over Tabone '587 in further view of Lin '481. Claim 42 stands rejected under 35 USC 103(a) as being obvious over Tabone '587.

In stating the rejections with regard to 35 USC 102(b) under Tabone FR '587 in page 4 of the Office Action lines 5 through 7, thereof the Examiner states:

"means (16) is capable of generating, subsequent to elapse of said effective time, a temperature difference between said microtome (9) and said cryostat chamber (1)"

Although the controller means 8 of Tabone could be modified in such a fashion as to create a temperature difference between the microtome and the chamber by differential drive of the lower heater 16 and the evaporator 4 in such a fashion as to create that temperature difference, this possible modification is irrelevant to the issue of anticipation. In particular, the elements of the claims are anticipated if and only if Tabone actually creates a temperature difference in the chamber and not if creation of such a temperature difference requires modification (re-programmung) of the controller 8. Towards this end, Tabone provides absolutely no indication that a temperature difference is generated between the microtome and the rest of the chamber. The Applicant has re-translated the relevant steps of the Tabone procedure given on pages 3 and 4 of the Tabone disclosure in steps 1 through 10. The relevant steps are 2, 3, 6 and 7 and are translated as follows:

2. Directing value V to invert the direction of circulation of the refrigerator fluid such that hot gas emitted by element 6 gain access to evaporator 4.
3. Simultaneous with step 2, activating base heater 16, wherein the combination of steps 2 and 3 assures elevation and stabilization of the temperature inside the chamber to an appropriate value of about 10 °C.

6. Renewed elevation and stabilization of the temperature for a period of time sufficient for the destruction of the viruses (minimum temperature of 60 degrees for at least one hour for the case of HIV virus or hepatitis B).
7. Simultaneous with step 6, activating the fan 17 to assure a uniform temperature within the chamber and to dry the microtome parts and electrical circuits in order to protect them.

There is no indication in the Tabone reference that a temperature differential is created between the microtome and the rest of the chamber. On the contrary, Tabone emphasizes the uniformity of the temperature distribution for both the higher temperature region of 60 degrees as well as the initial lower temperature of 10 °C. Therefore, the Tabone disclosure fails to read on the claimed temperature difference between the microtome and the chamber as recited in independent claim 34.

Claim 34 recites:

"means for generating, subsequent to elapse of said effective time, a temperature difference between said microtome and said cryostat chamber"

This recitation uses means plus function language in accordance with USC 112, sixth paragraph to recite the associated embodiments in the specification and equivalents thereto. In a preferred embodiment of the invention in accordance with figure 1, a temperature difference of approximately 25 degrees is generated during phases 15 and 16 between

the microtome T_m and the chamber T_k . In any event, the specification is clear (see page 7 paragraph 3 first sentence thereof) that a sufficient temperature difference must be generated in order to prevent deposition of disinfectant and moisture on the microtome. Although absolute uniformity of temperature can never be achieved within the device by Tabone, there is no indication in the Tabone reference that such substantial temperature differences between the microtome and the chamber, which are intrinsically recited through the means plus function language recitation of claim 34, are disclosed. The anticipation rejection of claim 34 under Tabone is therefore clearly incorrect.

Although claim 34 does not currently stand rejected under 35 USC 103 such a rejection would also be improper, since Tabone provides no motivation for a substantial temperature difference between the microtome and the chamber as claimed. On the contrary, Tabone emphasizes the uniformity of the temperature distribution within the chamber and uses a dual temperature means comprising the lower heater 16 in combination with the elements 6 and 4 not to create a temperature difference rather to create a uniform temperature. Moreover, such a temperature difference would make no sense within the context of the Tabone disclosure, since it would serve no useful purpose in order for Tabone to accomplish his intended goals of disinfecting the chamber and microtome. Claim 34 is therefore clearly distinguished from the Tabone reference with regard to the requirements of 35 USC 103.

The Applicant has chosen to present former claims 35 and 36 in independent form by incorporating the limitations of the respective base claim and any intervening claims. In so doing, independent claims 35 and

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36 recite still additional limitations concerning the temperature control precision within the microtome device as claimed. Tabone provides no motivation for such temperature differences and therefore fails to suggest the limitations of either claim 35 or claim 36, now recited in independent form.

The Applicant therefore submits that the invention is sufficiently distinguished from the prior art of record to satisfy the conditions for patenting in the United States and awaits allowance in the next Office Action.

No new matter has been added in this amendment.

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